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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,571

02/11/2004

David M. Hilbert

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EXAMINER

LIU, LIN

ART UNIT

PAPER NUMBER

2145

MAIL DATE

DELIVERY MODE

02/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,571	Applicant(s) HILBERT ET AL.	
	Examiner LIN LIU	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/09/2005, 04/08/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to communications filed on 02/11/2004.

Claims 1-30 are pending and have been examined.

2. The information disclosure statement (I.D.S) filed on 02/09/2005 and 04/08/2005 are considered.

Claim Objections

3. Claim 22 is objected to because of the following informalities: the instant claim recites "determining an identity of a sender", which is not presently supported by the specification (e.g. page 2, paragraph 8). The specification refers to "identity of the recipient". For the purpose of examination, the examiner interprets the instant claim as "determining an identity of a recipient".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 7, 14, and 26-28 recite the limitation "the attachment". There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, the examiner interprets this limitation as "the file attachment" to avoid the confusion with the "attachment reference".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-23, and 25-28 rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanna et al. (Patent no.: US 7,054,905 B1)** in view of **Arnold (Patent no. US 6,275,848 B1)**.

With respect to **claim 19**, Hanna teaches a system for processing electronic mail messages, the system comprising: a message parser configured to (Hanna: fig. 2):

accept an electronic mail message, the electronic mail message including a file attachment (Hanna: fig. 2, col. 4, lines 18-24, noted that email server 108 accepts email message including attachment.);

in response to a positive determination, store the file attachment in an attachment location (Hanna: col. 4, lines 29-37, noted that the attachment is stored in file server 111); and

insert an attachment reference associated with the attachment location and configured to cause the submission of validation information to a server storing the attachment location (Hanna: col. 5, lines 26-31 and lines 57-76, noted that URL address of the attachment is sent to the recipient with the modified message.); and

a attachment reference module configured to manage the generation of the hyperlink (Hanna: col. 5, lines 26-31, insertion of URL reference to the attachment file).

However, Hanna does not explicitly teach a method of determining whether to remove the file attachment.

In the same field of endeavor, Arnold teaches a method of determining whether to remove the file attachment (Arnold: fig. 2 steps 206-208, and col. 4, lines 6-24, noted that detachment rule is applied).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment rules of an attachment file as taught by Arnold in Hanna's invention in order to apply the filter criteria in detaching the file attachment from the email message before sending the message to the recipients. The advantage of such method is that it avoids having SMTP in handling multiple large attachments and preventing recipient's email applicant from crashing (Arnold: col. 1, lines 39-61).

With respect to **claim 20**, Hanna teaches the system of claim 19 wherein the attachment reference is a hyperlink (Hanna: col. 5, lines 26-31, URL reference).

With respect to **claim 21**, Hanna teaches all the claimed limitations, except that she does not explicitly teach a method of determining a size of the file attachment.

In the same field of endeavor, Arnold teaches determining a size of the file attachment (Arnold: col. 4, lines 58-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment a size of the file attachment as taught by Arnold in Hanna's invention in order to determine

Art Unit: 2145

whether, or how long, the attachment shall remain on the server (Arnold: col. 4, lines 58-67).

With respect to **claim 22**, Hanna teaches the system of claim 19, wherein determining whether to remove the file attachment comprises determining an identity of a recipient of the electronic mail message (Hanna: fig. 2, col. 4 lines 17-37, it is an inherent feature to identify the recipient's email address.).

With respect to **claim 23**, Hanna teaches a method of determining a type of the file attachment (Hanna: col. 4, lines 25-28).

With respect to **claim 25**, Hanna teaches the system of claim 24, wherein the executable is configured to prompt a recipient for validation information and then submit the received validation information to the server storing the attachment location (Hanna: col. 5, lines 8-16 & lines 57-67).

With respect to **claim 26**, Hanna teaches the system of claim 19, wherein the attachment is a media file (Hanna: col. 4, lines 25-28, noted the graphical image) and the system is further configured to stream the attachment to a recipient (Hanna: col. 4, lines 37-40).

With respect to **claim 27**, Hanna teaches the system of claim 19, wherein the attachment is a document including text and the system is further configured to translate the text (Hanna: col. 4, lines 25-28, document file).

With respect to **claim 28**, Hanna teaches the system of claim 19, wherein the server storing the attachment prompts a recipient for validation information when the recipient attempts to retrieve the attachment (Hanna: col. 5, lines 8-16 & lines 57-67).

With respect to **claim 4**, Hanna teaches the method of claim 1, further comprising generating a low bandwidth version of the file attachment upon request (Hanna: col. 4, lines 41-50 & col. 6, lines 6-11).

In regard to **claims 1-3, 5-18**, the limitations of these claims are substantially the same as those in claims 19-23, and 25-29. Therefore the same rationale for rejecting claims 19-23, and 25-29 is used to reject claims 1-3, 5-18. By this rationale **claims 1-3, 5-18** are rejected.

8. Claims 24, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanna et al. (Patent no.: US 7,054,905 B1)** in view of **Arnold (Patent no. US 6,275,848 B1)** and further in view of **Le Pennec et al. (PGPUB: US 2005/0076082 A1)**.

With respect to **claims 29 and 30**, the combined method of Hanna and Arnold teaches attaching a URL reference to the email message (Hanna: col. 5, lines 26-31, URL reference). However, Hanna-Arnold does not explicitly teach a method of attaching a data file as attachment reference, and wherein the data file is configured to enable an application stored on a recipient computer to retrieve the attachment from the server storing the attachment.

In the same field of endeavor, Le Pennec teaches a method of attaching a data file as attachment reference, and wherein the data file is configured to enable an application stored on a recipient computer to retrieve the attachment from the server storing the attachment (Le Pennec: page 2, paragraph 27, noted the executable file is attached to the original email message).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the method of attaching an executable data file as taught by Le Pennec in the combined method of Hanna-Arnold's invention in order to download the original attachment files from the server. The advantage to integrate such method is that it bypasses the file attachment size limitation, and avoids sending large files and overloading the user's mailbox (Le Pennec page 1, paragraphs 10-11).

In regard to **claim 24**, the limitation of this claim is substantially the same as those in claims 29-30. Therefore the same rationale for rejecting claims 29-30 is used to reject claim 24. By this rationale **claim 24 is rejected**.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kobata et al. (PGPUB: US 2003/0023695 A1) discloses a method of modifying an email system to produce a secure delivery system.
- Tsai (Patent no.: US 6,839,741 B1) discloses a method for distributing and providing access to email message attachments.
- Pollack (Patent no.: US 6,505,236 B1) discloses a method of detaching email attachment files from an email message.

Art Unit: 2145

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447.

The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. L./

Examiner, Art Unit 2145

/Lin Liu/

Examiner, Art Unit 2145

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145